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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,722	10/06/2003	Duane D. Miller	20609/203 (PD 00034)	2869

7590 04/11/2005

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EXAMINER
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AULAKH, CHARANJIT

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 04/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/679,722

Applicant(s)

MILLER ET AL.

Examiner

Charanjit S. Aulakh

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2005.  
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-44 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. According to paper filed on Feb. 3, 2005, the applicants have amended claims 1, 2, 4, 5, 24, 34 and 35.
2. Claims 1-44 are pending in the application.

### ***Response to Arguments***

3. Applicant's arguments filed on Feb. 3, 2005 have been fully considered but they are not persuasive regarding enablement and some indefiniteness rejections. The applicants have submitted a declaration to remove Zheng's reference as a prior art reference and therefore, to overcome obviousness rejection. In regard to enablement rejection, the examiner does not agree with the applicants arguments that the instant specification is enabling for treating every possible known and yet unknown condition mediated by alpha2a or alpha2c receptors. The instant bivalent yohimbine dimer compounds are selective alpha2c receptor antagonists as compared to alpha2a and alpha2b receptor subtypes as mentioned on page 29, lines 30-31 based on experimental evidence presented in tables 4 (see page 29 ) and table 2 ( see page 26 as well as page 27, lines 2-8 ). Based on these data, the instant compounds will have utility in treating only those conditions where adrenergic alpha2c antagonists were well known in the prior art ( before effective filing date of the instant application ) to have therapeutic utility. There is no teaching either in the specification or prior art reference provided to show well known utility of alpha2c receptor antagonists. There is no teaching either in the specification or prior art showing hyperactivity of alpha2c receptors responsible for the etiology of any disease condition. There are no working

Art Unit: 1625

examples present to show efficacy of instant compounds in known animal models of any disease condition.

In regard to indefiniteness rejections, the applicants did not specify the condition or disorder which are mediated by alpha2a or alpha2c receptors in claim 1.

NEW GROUNDS OF REJECTION

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 24-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In independent claims 24 and 34, it is not clear whether the activity is being inhibited in vitro or in vivo? and furthermore, how this inhibition is being assessed either in vitro or in vivo?

***Conclusion***

6. Rejection of claims 1-44 under 35 U.S.C. 112, first paragraph is maintained for the reasons of record.

7. Rejection of claims 1-23 under 35 U.S.C. 112, second paragraph is maintained for the reasons of record.

8. Rejection under 35 U.S.C. 103(a) is now withdrawn in view of declaration.

Art Unit: 1625

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

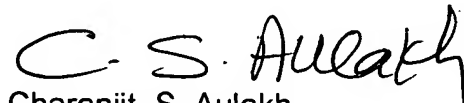
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charanjit S. Aulakh whose telephone number is (571)272-0678. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on (571)272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Charanjit S. Aulakh  
Primary Examiner  
Art Unit 1625